

III. REMARKS

Status of the Claims

Claims 1, and 17-19 are amended. Claims 1-20 are presented for further consideration. Claims 1,10, 17, 19, and 20 are independent.

The claims are amended for clarification. No new matter is presented. The amendments to the claims are not intended to be limiting, are not made for reasons related to patentability, and should not be interpreted to raise issues of estoppel.

Claims 17 and 18 are amended in response to the rejection under 35USC101. Claims 1 and 19 are amended to correct deficient antecedent basis. These amendments are submitted after final rejection in order to place the claims in condition for allowance or in the alternative to place the claims in better condition for appeal. Applicant submits that such amendments are properly entered under 37USC1.116. The Examiner is respectfully requested to enter these amendments in order to advance the prosecution of this application.

In rejecting the claims, the examiner has cited, for the first time, the reference Sudoh as a basis for the obviousness rejections. The citation of this new reference was not necessitated by Applicant's prior amendments and accordingly the issuing of final rejection is improper under MPEP section 706.07(c) where it is stated:

"While the rules no longer give to an applicant the right to "amend as often as the examiner presents new references or reasons for rejection," present practice does not sanction hasty and ill-considered final rejections. The applicant, who is seeking to define his or her invention in claims that will give him or her the patent protection to which he or she is justly entitled should receive the cooperation of the examiner to that end, and not be prematurely cut off in the prosecution of his or her application."

The Applicant argued in the prior response with regard to the distinguishing features of the reference Tsunoda. There has been no opportunity for Applicant to distinguish the teaching of Sudoh. The Examiner is respectfully requested to reconsider the final nature of the pending office action and his rejection in view of the above amendments and the following arguments. The entering of the above amendments will permit the clarification of the issues for appeal or the allowance of the claims.

Applicant has considered the Examiner's comments set forth in the Office Action mailed November 7, 2008 and responds in detail below. Reconsideration of the application is respectfully requested in view of the amendments and the following remarks.

The Office Action

Applicant submits that this amendment to claims 17 and 18 fully remedies the basis for the rejection under on 35USC101.

Claims 1-20 are rejected under 35USC103(a) based on the combined teaching of the reference Sudoh, US Publication No. 2006/0053468 and the cited reference Chandler, U.S. Patent No. 7,174,177. This rejection is traversed on the following grounds:

The combined teaching of Sudoh and Chandler does not render claims 1-20 obvious because it fails to teach or otherwise suggest each and every limitation of the claims. It is well settled that in order to establish a prima facie case for obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, without reference to the disclosure of this application. (MPEP Section 2142) ***In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.***

In particular claim 1 states:

“an application program for composing a multimedia message having a size, and wherein the device is configured to store a multimedia message size limit defined by a network, so that said multimedia message size limit is available for the application program during composition”

Independent claims 10, 17, 19, and 20 have equivalent limitations. The independent claims, accordingly recite that a message size limit is defined by a network. Sudoh fails to disclose that the size limit is defined by the network and this is acknowledged by the Examiner. Hence, the technical solution disclosed by Sudoh is incapable of adjusting to different needs of different communication networks. The Examiner cites the reference Chandler to remedy this deficiency with respect to the teaching of Sudoh

Chandler teaches that a message size limit (an indication of a maximum tele-service payload size) may be used at a network sending entity that is arranged to send tele-service messages to a mobile station in such a manner that re-segmentation and re-transmission can be avoided. The network sending entities mentioned by Chandler (e.g. SMSCs, MCs, WAP-servers) are devices that are arranged to forward (relay) tele-service messages inside a telecommunication network.

Chandler fails to teach the utilization of a message size limit in a device in which a (multimedia or any other) message is being created. Therefore, the teaching of Chandlers would not lead a skilled person to modify the technical solution disclosed by Sudoh in such a manner that the skilled person would obtain the technical solution recited in the independent claims of the present application.

The solution of the claimed subject matter as amended provides the following advantage that is mentioned in page 3, lines 21-24 of the corresponding PCT-publication W02005/088992:

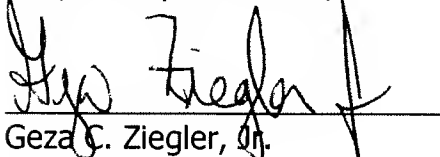
"An advantage of the invention is that the user is already when composing a message aware of the size limit and the transmission- related consequences of surpassing the limit. Thus the user already when composing the message is aware of the relation of the message size to the defined size limit."

Sudoh does not teach or suggest the above-mentioned advantage. Nor does Chandler present any teaching that would provide the above-mentioned advantage. Therefore, Applicant submits that the combined teaching of the references Sudoh and Chandler fails to support the rejection based on obviousness. These grounds apply equally to the rejected dependent claims, all of which, by dependency, have the limitations described in the independent claims.

For all of the above reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,



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